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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,585	11/12/2001	Ronald Breslow	0575/57474-A/JPW/ADM	7720

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 01/09/2003

*6*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,585

Applicant(s)

BRESLOW ET AL.

Examiner

Thomas McKenzie Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 14-32 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

**DETAILED ACTION**

1. This action is in response to an application filed on 11/12/01. There are twenty claims pending and nineteen under consideration. Claims 14-18 are compound claims. Claims 19-27 are composition claims. Claims 28-32 are use claims. This is the first action on the merits. The application concerns some phthalocyanine compounds, compositions, and uses thereof.

2. In Applicants' preliminary amendment, they canceled claim 6 and then amended claim 6. The amendment was not entered because the claim had been canceled.

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to cyclodextran compounds, classified in class 536, subclass 6.5.
- II. Claims 14-32, drawn to phthalocyanine compounds, classified in class 540, subclass 121.

4. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be

useful as a host compound for other drug molecules and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Alan Morrison on 12/20/02 a provisional election was made with traverse to prosecute the invention of Group II, claims 14-32. Applicant in replying to this Office action must make affirmation of this election. Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Applicants' unofficial FAX of 12/20/02 is noted. Applicants' arguments concerning the traversal of the restriction will be considered in response to this action to avoid duplication of effort.

***Abstract***

8. Applicant is reminded of the proper content of an abstract of the disclosure. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." The abstract is too short and generic. Examiner suggests claim 14, including the figure, and the utility.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 19-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Applicants offer  $\text{CO}_2^-$ ,  $\text{N}^+(\text{CH}_3)_3$ , and  $\text{SO}_3^-$  as possible variants for  $\text{R}_1$ . What counter ions are intended? The Examiner understands that the zinc ion has a formal +2 charge and that charge is balanced by the two formal -1 charges on two of the phthalocyanine nitrogen atoms. Therefore there is no balancing charge for the substituents, *Ex parte Diamond* 123 USPQ 167.

10. Claims 14 and 19-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants offer " $\text{C}_1$ - $\text{C}_4$  alkyl" as possible variants for X. An alkyl group is a monovalent radical and X must be divalent. The nitrogen, oxygen, and sulfur alternatives for X are all divalent. In the last two lines of claim 1, Applicants use alkyl correctly for the monovalent radical  $\text{R}_2$ . The Examiner suggests " $\text{C}_1$ - $\text{C}_4$  alkylene".

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating specific cancers in patients suffering from cancer, does not reasonably provide enablement for killing tumor cells *in vitro*. The

specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification fails to teach any benefit to be gained from such actions. Is extensive experimentation required on the part of a potential infringer to determine if his use of Applicants' composition falls within the limitations of Applicants' claim? *In re Kirk and Petrow*, 153 USPQ 48 (CCPA 1967).

12. Claims 28-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for treating tumors generally. The specification does not enable any physician skilled in the art of medicine, to use the invention commensurate in scope with these claims. There are three grounds for making this rejection. Firstly, evidence involving a single compound and two types of cancer was not found sufficient to establish the enablement of claims directed to a method of treating seven types of cancer with members of a class of several compounds *In re Buting* 163 USPQ 689.

Secondly, to make clearer the lack of enablement for treatment of all cancer, extrinsic evidence is supplied by Draetta (Ann. Reports Med. Chem.), final sentence on page 246 "Although many still think about the need for a magic bullet as a cure for all cancers, our knowledge of the molecular mechanism underlying

this disease make the prospect of developing such a universal cure very unlikely.” Since no universal cure for cancer has been developed, it follows that there could be no correlation between any bioassays relied upon by Applicants and the ability to treat all cancers.

Thirdly, Lane (Sci. Amer.) reports in the fourth through the seventh paragraph on page 41 that phototherapy has not shown efficacy against all tumors. In the absence of any biological test data, why do Applicants feel their compounds will specifically target any specific tumor cell, let alone all tumor cells? The remarkable advances in chemotherapy have seen the development of specific compounds to treat specific types of cancer. The great diversity of diseases falling within the “tumor” category means that it is contrary to medical understanding that any agent (let alone a genus of thousands of compounds) could be generally effective against such diseases. The intractability of these disorders is clear evidence that the skill level in this art is low relative to the difficulty of the task.

***Allowable Subject Matter***

13. The following is a statement of reasons for the indication of allowable subject matter: Applicants' compound claims are novel over Krutak ('516) who teaches esters of oxy-benzoic acid substituted phthalocyanine compounds, does not teach Applicants required fused ring formed by variables R and X.




**Conclusion**

14. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. The FAX number for before final amendments is (703) 872-9306. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, you can reach the Examiner's supervisor, Mukund Shah at (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.

TCMcK  
December 30, 2002



  
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